

WSHU 2064.1
PATENT**REMARKS**

The Office asserts that restriction of the claimed invention is required because the "inventions are distinct, each from the other."¹ The Office requests that Applicant elect one of the following sixteen groups of claims for search and examination: Group I (claims 1-10, 24, 25, 30, 41, 42, 44, 45, 47-52, 54-63, 80-82 and 84-88), Group II (claims 11, 12, 22, 23, 64, 65, 72, and 73), Group III (claims 13-21, 31, 43, 46, 53, 66-71, 74, 76-79, and 83), Group IV (claim 26), and Group V (claim 27), Group VI (claim 28), Group VII (claim 29), Group VIII (claims 32 and 75), Group IX (claims 33 and 75), Group X (claims 34 and 75), Group XI (claims 35 and 75), Group XII (claims 36 and 75), Group XIII (claims 37 and 75), Group XIV (claims 38 and 75), Group XV (claims 39 and 75), and Group XVI (claims 40 and 75).

In response thereto, Applicant respectfully requests the Office to consider the relative burdens on it and Applicant as well as the similar nature of these claims as directed by MPEP §803:

If the search and examination of an entire application can be made *without serious burden*, the examiner *must examine* it on the merits, even *if it includes claims to independent or distinct inventions*. (emphasis added)

With this standard in mind, Applicant asserts that the search and examination of the claims represented by Groups III and VIII-XVI of the application can be made without

¹Office action mailed July 13, 2005, page 5.

WSHU 2064.1
PATENT

serious burden to the Office. As stated by the Office, the claims of Group III are directed to transgenic plant cells and plant seeds transformed by an OBP antisense coding nucleic acid expression vector, a recombinant antisense expression vector comprising a nucleotide sequence of SEQ ID NO: 1 or variants thereof, and a method for producing a transgenic plant having increased size comprising an OBP antisense nucleotide. Notably, the common thread among these claims is the use of an antisense nucleotide sequence, and in particular embodiments, the use of an antisense nucleotide sequence SEQ ID NO: 1.

The claims of Groups VIII-XVI relate to the claims of Group III in that they merely further specify a particular antisense coding nucleotide sequence. Specifically, each of these claims depends from either claim 31 or 74 of Group III and merely recites that the nucleotide sequences be at least 15 contiguous nucleotides of one of SEQ ID NOS: 12-20. Accordingly, these claims merely require that the Office search and examine an additional nine sequences that would be used to perform essentially the same antisense coding function. The total number of sequences to be searched, therefore, would be ten. Applicant asserts that such a search may be performed without serious burden to the Office.

In contrast to the minimal burden that would result from searching the related nine groups, Applicant's burden of having to prosecute and maintain nine additional applications would be quite serious. Applicant would be forced to incur filing fees of about \$4,500, issue and publication fees of about \$6,300, and maintenance fees of about \$31,500 or more if required to prosecute and maintain

WSHU 2064.1
PATENT

nine additional applications/patents. These fees would be, of course, in addition to the fees to be incurred in the present application.

Moreover, while nucleotide sequences encoding different proteins are deemed to normally constitute independent and distinct inventions according to MPEP §803.04, Applicant respectfully reminds the Office that MPEP §803.04 also states that

Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent

WSHU 2064.1
PATENT

and distinct inventions and will continue to be
examined together. (emphasis added)

In this particular instance, the sequences listed in the claims of Group III and Groups VIII-XVI constitute a reasonable number of sequences. Specifically, the claims of these groups recite a total of ten different nucleotide sequences (SEQ ID NOS: 1 and 12-20). This is deemed to be a reasonable number of sequences per the Commissioner's *sua sponte* declaration cited in MPEP §803.04.

Accordingly, a search and examination of each of the claims of Groups III and VIII-XVI is both proper and required pursuant to MPEP §803.04.

Subject to the foregoing traverse, should the Office maintain the restriction requirement, Applicant provisionally elects the claims of Group III (claims 13-21, 31, 43, 46, 53, 66-71, 74, 76-79, and 83).

Applicant acknowledges the statement that claim 75 is generic to Groups VIII-XVI and that claim 75 will be examined to the extent that it is drawn to the elected invention.

Applicant reserves the right to file divisional applications directed to the non-elected subject matter.

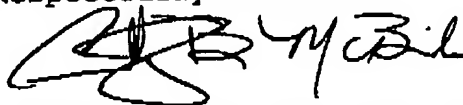
WSHU 2064.1
PATENT

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

The Office is authorized to charge the amount of \$510.00 to Deposit Account No. 19-1345 for the extension of the response period to and including November 13, 2005. The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayments to Deposit Account No. 19-1345.

Respectfully submitted,



Timothy B. McBride, Reg. No. 47,781
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

TBM/sxm

Via Facsimile (571) 273-8300

Mail Stop Amendment